

# Notice of Allowability

## Application No.

09/664,827

## Examiner

Suryaprabha Chunduru

## Applicant(s)

ERIKSON ET AL.

## Art Unit

1637

### -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 10/15/04.
2. ☒ The allowed claim(s) is/are 1,3-10,12-43 and 47-50.
3. ☒ The drawings filed on 19 September 2000 and 18 January 2002 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment                    |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material          | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance   |
|   | 9. <input type="checkbox"/> Other _____.   |

JEFFREY FREDMAN  
PRIMARY EXAMINER

Art Unit: 1637

**DETAILED ACTION**

1. Applicants' response to the office action filed on October 15, 2004 has been entered and considered.
2. Claims 1, 3-10, 12-51 pending, with claims 26-29 being withdrawn from consideration pursuant to a restriction requirement.
3. The terminal disclaimer filed on 12/1/04 is considered.

***Examiner's Amendment***

4. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with David M. Tener on November, 5, 2004.

Please amend the claims as follows:

Cancel claims 44-46, and 51.

The following is an examiner's statement of reasons for allowance:

Applicants' request to rejoin the method claims with allowable product claims (MPEP § 821.04), is considered.

Claims 1, 3-10, 12-25 are directed to an allowable product. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims 26-43 47-50, directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement,

Art Unit: 1637

found allowable now subject to being rejoined. Claims 26-43, 47-50 hereby rejoined and fully examined for patentability under 37 CFR 1.104. Claims 44-46 and 51 do not commensurate in scope with allowed product and are not rejoined, and are cancelled as per the authorization.

The rejoinder of method claims resulted in double patenting issue. Upon consulting the Applicants' Attorney, a terminal disclaimer was filed to overcome the double patenting issue raised by the examiner, which is fully considered and entered.

***Allowance:***

5. Claims 1, 3-10, 12-43, and 47-50 are allowed.

The present invention is drawn to a multiplex structure and a method for providing said multiplex structure comprising a first strand containing a first sequence of nucleobases; a second strand containing a second sequence of nucleobases, wherein said second strand is associated with said strand by Watson-Crick bonding; a third strand containing a third sequence of nucleobases; and a fourth strand containing a fourth sequence of nucleobases, wherein said fourth strand is associated with said second and said third strand by Watson-Crick bonding, at least one nucleobase of said fourth sequence of nucleobases and to at least one nucleobase of said sequence of nucleobases and to at least one nucleobase of said second sequence of nucleobases, each nucleobase in said second sequence and said fourth sequence binds to two other nucleobases and said multiplex structure is isolated, purified, artificial or synthetic.

Applicants' arguments on the closest prior art rejection under 35 USC 102(b) as anticipated by McGavin et al. and 35 USC 103(a) over McGavin et al. (J. Mol. Graphics, Vol. 7, pages 218-232, 1989) in view of George Jr. (USPN. 5,451,502) are fully considered. Applicants

Art Unit: 1637

argue that the rejection of the instant claims is based on an improper non-enabling art and "obvious-to-try" standard of obviousness with no reasonable expectation of success and the theoretical teachings of McGavin reference is a non-enabling art according to In re Payne and argue that there is no motivation to modify the primary reference (George et al.) with the teachings of McGavin et al. to reach the claimed invention with a reasonable expectation of success. These arguments are fully considered and found persuasive. The rejections are withdrawn herein and the claimed invention is found to be non-obvious and novel based on the persuasive arguments.

Thus the instant invention was not taught or obvious over the closest prior art.

### ***Conclusion***

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 571-272-0783. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and - for After Final communications.

Art Unit: 1637

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

<sup>CKZ</sup>  
Suryaprabha Chunduru.  
December 13, 2004.

  
JEFFREY FREDMAN  
PRIMARY EXAMINER  
12/15/04